

REMARKS

Claims 15 and 16 are pending in this application. Claim 15 is the only independent claim.

By this amendment, claim 15 is amended.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Copies of Initialed PTO-1449 Requested

Applicant respectfully requests a copy of the initialed PTO-1449 submitted on January 19, 2006.

In reviewing the application file, the undersigned has noted that the appropriate initialed Form PTO-1449 in response to the Information Disclosure Statement (IDS) filed on January 19, 2006 has not been received by Applicant. The Examiner is therefore requested to return a copy of the initialed Form PTO-1449 to the undersigned as soon as possible.

The Claims Define Patentable Subject Matter

The Office Action rejects:

Claims 15 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,684,864 to Shibata (hereafter Shibata) in view of U.S. Patent No. 4,129,073 to Ritzerfeld (hereafter Ritzerfeld).

This rejection is respectfully traversed.

Applicant respectfully submits that the claimed invention is distinguishable from the combination of Shibata and Ritzerfeld for at least the following reasons:

The Examiner alleges that Shibata discloses a communication device 110 for receiving an identification signal from an originating communication apparatus 100 and performing an output operation when the received identification signal coincides with a pre-stored identification

signal. (see Office Action, page 2). Applicant respectfully submits that this feature of Shibata is distinguishable from the present application.

For example, while Shibata discloses a PC-FAX function whereby a fax receives telephone number information and image information transmitted from an external PC, Shibata fails to teach or suggest receiving an identification signal from an originating communication apparatus, wherein the identification information identifies the originating apparatus.

In other words, Shibata merely discloses that the telephone number for the printing function is registered. This "printing function telephone number" only identifies the destination facsimile apparatus which will perform the printing operation. In other words, the "printing function telephone number" in Shibata fails to identify an originating communication apparatus.

In Shibata, the PC 100 (originating apparatus) sends a dialing command to the facsimile apparatus 110 (destination apparatus). The dialing command consists of an ATD command and a print control command. In Shibata, the facsimile apparatus 110 uses this dialing command to perform an output operation. As such, in Shibata the PC 100 is the originating apparatus and the facsimile apparatus 110 is the destination apparatus. Therefore, the facsimile apparatus in Shibata fails to receive from the PC 100 an identification information identifying the PC. Instead, the facsimile 110 only receives an identification telephone number identifying the facsimile itself. As such, Shibata fails to disclose receiving an identification signal from an originating apparatus that identifies the originating apparatus. Ritzerfeld also fails to teach or suggest such a feature.

Furthermore, as admitted by the Examiner, Shibata fails to disclose grouping the plurality of copies of the entire document into a plurality of groups. (see Office Action, page 3). However, in an attempt to show this feature, the Examiner imports Ritzerfeld.

Specifically, the Examiner alleges that Ritzerfeld supports that it is well-known to disclose a copy machine which copies a plurality of copies and groups them into a plurality of groups for different uses or different destinations by adding different pre-printed sheets to distinguish the different groups. (see Office, page 3). Applicant respectfully disagrees with the Examiner's interpretation of Ritzerfeld as it relates to the present application.

For example, Ritzerfeld merely discloses a duplicator machine that includes marking means for providing successive copies with appropriate routing markings. These routing markings in Ritzerfeld are indicative of the intended uses or intended destinations for the successive copies. However, Applicant respectfully submits that Ritzerfeld's application of routing markings on the copies is not the same as performing a conditional output operation wherein a plurality of copies are printed into a plurality of groups.

For example, in the present invention, the output operation is performed when the received identification signal from the originating communication apparatus coincides with a pre-stored identification signal. In Ritzerfeld, the duplicator machine fails to receive an identification signal from an originating communication apparatus. Instead, Ritzerfeld's duplicator machine is merely a copying machine that includes a marking means in the path of travel of the copies. However, Ritzerfeld's duplicator machine fails to be able to receive identification information from other communication devices and to perform output operations based thereon. As such, Applicant respectfully submits that Ritzerfeld's system is quite distinguishable from the present application and is also quite distinguishable from and non-combinable with Shibata's system.

Applicant respectfully submits that neither Shibata nor Ritzerfeld, taken singularly or in combination, (assuming these teachings may be combined, which applicant does not admit) teach or suggest being able to receive identification information from other communication devices and to perform output operations based thereon, and the identification information fails to identify an originating communication apparatus..

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the examiner has failed to establish a *prima facie* case of obviousness at least in part because the examiner has failed to show how each and every feature is taught by the cited art.

Applicant respectfully submits that the examiner has failed to show any suggestion or motivation from either the references themselves or in the knowledge generally available to one of ordinary skill in the art why it would be proper to combine the cited references. Instead, the Examiner is merely relying on improper hindsight.

Applicant respectfully submits that the combination of cited art fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claim 15 is allowable over the combination of cited art for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 15 and 16 under 35 U.S.C. §103(a) is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview.**

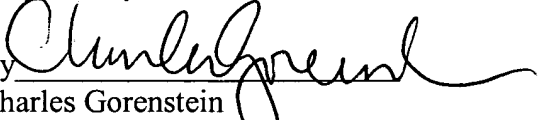
Application No. 10/601,655
Amendment dated January 10, 2007
Reply to Office Action of October 16, 2006

Docket No.: 1247-0516P
Page 7 of 7

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

By 

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